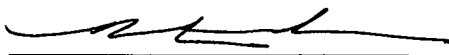


REMARKS

The foregoing amendments are made to insert sequence identifiers. No new matter is added. Entry of the amendments is respectfully requested.

Respectfully submitted,

Date: 5/22/06

By: 
Roberta L. Robins
Registration No. 33,208
Attorney for Applicants

Robins & Pasternak LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel: 650 493-3400
Fax: 650 493-3440



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09/766,273

Oligonucleotide-tagged semiconductor hybridization

Select New Case	Application Data	Transaction History	Image File Wrapper	Continuity Data	Publication Documents
-----------------	------------------	---------------------	--------------------	-----------------	-----------------------

Transaction History

Date	Transaction Description
04-25-2006	Mail Restriction Requirement
04-24-2006	Requirement for Restriction / Election
04-19-2006	Case Docketed to Examiner in GAU
04-12-2006	Date Forwarded to Examiner
11-20-2002	Response to a Letter to Comply with the Sequen
04-13-2006	Mail Notice of Rescinded Abandonment
04-12-2006	Notice of Rescinded Abandonment in TCs
12-08-2003	Correspondence Address Change
12-09-2003	Change in Power of Attorney (May Include Assoc
07-20-2003	IFW TSS Processing by Tech Center Complete
07-20-2003	IFW TSS Processing by Tech Center Complete
07-20-2003	IFW TSS Processing by Tech Center Complete
07-20-2003	IFW TSS Processing by Tech Center Complete
04-03-2003	Information Disclosure Statement (IDS) Filed
02-12-2003	Petition to Revive Application - Granted
11-24-2002	Petition Entered
12-13-2002	CRF Is Good Technically / Entered into Database
10-25-2002	Mail Abandonment for Failure to Respond to Offi
10-25-2002	Abandonment for Failure to Respond to Office Ac
04-15-2002	Information Disclosure Statement (IDS) Filed
04-15-2002	Information Disclosure Statement (IDS) Filed
03-28-2002	Case Docketed to Examiner in GAU
03-20-2002	Mail Letter Requiring CRF (Unreadable, Non-Con
03-20-2002	CRF Diskette Unreadable / Did Not Comply / Rec
02-19-2002	Information Disclosure Statement (IDS) Filed
02-21-2002	CRF Does Not Match Application Specification --
02-12-2002	Date Forwarded to Examiner
12-26-2001	Response to Election / Restriction Filed
02-07-2002	Case Docketed to Examiner in GAU
11-27-2001	Mail Restriction Requirement
11-26-2001	Requirement for Restriction / Election
10-04-2001	Petition Decision - Granted

06-25-2001	Petition Entered
05-30-2001	Preliminary Amendment
09-21-2001	Case Docketed to Examiner in GAU
08-31-2001	Application Dispatched from OIPE
03-29-2001	Application Is Now Complete
03-29-2001	Application Is Now Complete
08-03-2001	Correspondence Address Change
07-09-2001	CRF Is Good Technically / Entered into Database
03-29-2001	Notice Mailed--Application Incomplete--Filing Da
03-28-2001	Correspondence Address Change
02-06-2001	IFW Scan & PACR Auto Security Review
01-18-2001	Initial Exam Team nn

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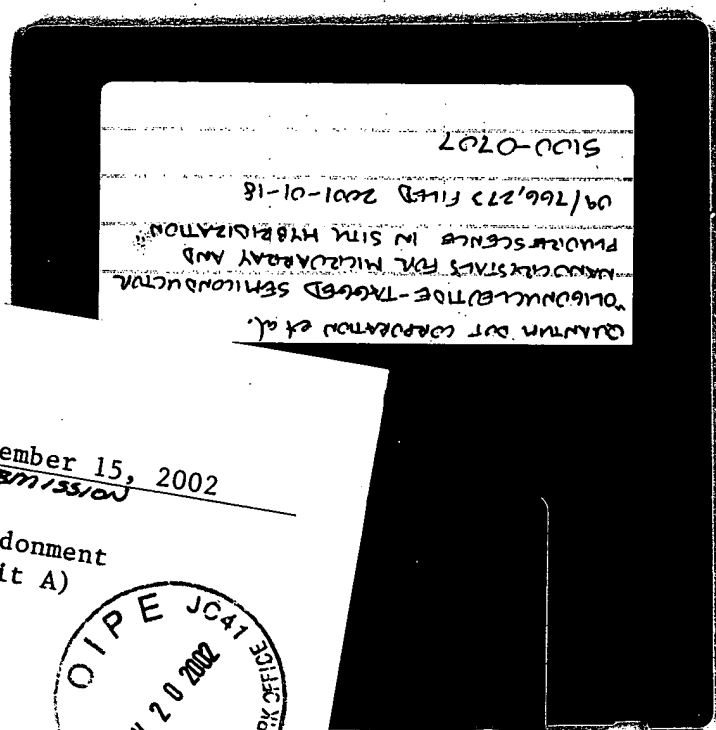
ATTORNEY DOCKET 5100-0707DATE November 15, 2002

- Transmittal Letter
- Petition to Withdraw Holding of Abandonment
- Copy of Notice of Abandonment (Exhibit A)
- Copy of Mail Logs (Exhibit B)
- Supplemental Amendment
- Hardcopy of Sequence Listing
- Floppy Disk of Sequence Listing

PAPER: _____

INVENTOR: Bittner et al.SERIAL NO.: 09/766,273FILING DATE: January 18, 2001

RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET 5100-0707DATE November 15, 2002**STATEMENT TO SUPPORT FILING AND SUBMISSION**

- Transmittal Letter
- Petition to Withdraw Holding of Abandonment
- Copy of Notice of Abandonment (Exhibit A)
- Copy of Mail Logs (Exhibit B)
- Supplemental Amendment
- Hardcopy of Sequence Listing
- Floppy Disk of Sequence Listing

PAPER: _____

INVENTOR: Bittner et al.SERIAL NO.: 09/766,273FILING DATE: January 18, 2001

RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

Atty Dkt No. 5100-0707
PATENT

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on November 15, 2002

11/15/02
Date

Narinder S. Banait
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Bittner et al.

Serial No.: 09/766,273

Group Art Unit: 1634

Filing Date: January 18, 2001

Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN
SITU HYBRIDIZATION

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed are the following:

- 1) Petition to Withdraw Holding of Abandonment;
- 2) Exhibit A - (copy of Notice of Abandonment);
- 3) Exhibit B - (copy of Mail Logs);
- 4) Supplemental Amendment;
- 5) Statement to Support Filing and Submission;
- 6) Hardcopy of the Sequence Listing;
- 7) Floppy diskette of Sequence Listing; and
- 8) Return postcard.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: November 15/2002

By: *Narinder S. Banait*
Narinder S. Banait
Registration No. 43,482

ROBINS & PASTERNAK LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Facsimile: (650) 325-7823

COPY

Atty Dkt No. 5100-0707
USSN: 09/766,273
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael Bittner *et al.*

Serial No.: 09/766,273

Art Unit: 1634

Filing Date: January 18, 2001

Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN
SITU HYBRIDIZATION

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Box DAC
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants provide this Petition pursuant to the provisions of 37 CFR §1.181(a) and MPEP §711.03(c)II in order to withdraw a holding of abandonment on the above-identified application. In particular, applicants received a Notice of Abandonment dated October 25, 2002 for failure to timely file a proper reply to the Office letter mailed on March 20, 2002. A copy of the Notice is attached as Exhibit A. However, applicants did not receive the March 20, 2002 letter. It is normal practice to enter the PTO mailings into the MAIL LOG docketing system on a day of the receipt of the mail. Applicants include copies of the docket for the period of March 20, 2002 through April 2, 2002, appended hereto as Exhibit B. The docket indicates that the Office letter was not received.

Accordingly, applicants submit that the application should not have been abandoned and respectfully request that the application be reinstated.

Applicants include a reply to the Office Action mailed on March 20, 2002, as required by MPEP §711.03(c).

The Office is authorized to pay any additional fees which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: November 15/2002

By: Narinder S. Banait
Narinder S. Banait
Registration No. 43,482

ROBINS & PASTERNAK LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Fax: (650) 325-7823

COPY

EXHIBIT A

COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,273	01/18/2001	Michael Bittner	22564-0707	1332

20855 7590 10/25/2002

ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

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ROBINS & PASTERNAK LLP

5100-0707

EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/25/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED NSB

5100-0707

Petition to Revoke/
Withdraw Holding
of Abandonment
11/30/02

Notice of Abandonment

Application No.

09/766,273

Examiner

Sally A Sakelaris

Applicant(s)

BITTNER ET AL.


Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 20 March 2002.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


CARLA J. MYERS
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

COPY

EXHIBIT B

MAIL LOG
March 20, 2002

COPY

ATTY DOC # DESCRIPTION
rcv'd via courier 3-19

RLR	7011-XXX	new US provisional patent applications (2)
DSP	6750-xxxx	ltr fr Cooley w/correspondence for transferred files
DSP	8325-0020	ltr re IDS
DSP	8325-0018.40	ltr re do not request Chapter II processing
DSP	8325-0019.40	ltr re do not request Chapter II processing
GRF	2750-0230.01	ltr w/copy of issued patent 6,356,776
RLR	8400-0010	Advisory Action
DSP	2300-1621.41	so.africa copy of executed Assignment
DSP	2300-1527.	Ltr w/copy of Notice of Allowability
RLR	2300-0953.52	cc ltr fr Chang to Chiron re filed Amendment
DSP	6750-0001.40	PCT-Notice Informing the Applicant of the Communication If the Intl...
RLR	2302-1631.20	copy of Declaration of Susan E. Wilson
RLR	7050-0003.10	fr Roche documents for our file
DSP	6750-0007.45	ltr fr Cooley correspondence for transferred files

MAIL LOG
March 21, 2002

COPY

<u>ATTY</u>	<u>DOC #</u>	<u>DESCRIPTION</u>
RLR	9000-0057.40	ltr fr Gowlings w/copy of PCT Intl. Search Report
RLR	9000-0055.40	ltr fr Gowlings w/copy of PCT Intl. Search Report
DSP	2300-0999	ltr w/copy of Office Action
RLR	2300-0946.20	ltr w/copy of U.S. Patent 6,355,247
DSP	8325-0007.43	conf. copy ltr fr Mewburn re entering regional phase at EPO
RLR	0800-0008.41	CPA-Official Receipt
RLR	2300-1651.	ltr requesting preparing and filing application
GRF	2750-0209.03	ltr w/copy of Corrected Filing Receipt

March 22, 2002

COPY

PTO	Notice of Publication - 09/915,947 (3930-0804.01)
PTO	Not. File Miss. Pts. & OFR - 10/084,826 (8325-0014.20)
PTO	RLR - postcard confirming req. for Cert. of Corr. - Patent # 5,858,351
EP/ISA	DSP - Notif. of Receipt of Search Copy - PCT/US01/49623 (8600-0010.40)
EP/ISA	DSP - PCT/ISA/224 - delay of ISR establishment (8600-0010.40)
TIPLO	RLR - OA, rsp due 3-May-02 (5998-0019.42)
PTO	Decision on petition (Granted) (3941-0001.20)
BGL	RLR - cc of letter to Chiron (2302-6146.41)
F B RICE	RLR - reminder of rsp due 11-Sep-02 (2302-1413.44)
PTO	monthly statement of deposit account; closing balance 4265.00
J A KEMP	cc of letter (oral proceedings minutes) to Chiron
PTO	Office Action, PTO-892, 4 cited refs (5050-0022)
Cygnus	GRF - copy of PCT published application - 2750-0240.40
Cygnus	GRF - copy of PCT published application - 2750-0242.40
Cygnus	GRF - copy of PCT published application - 2750-0243.40
Marvel, O'Farrell & Mairal	brief requesting examination & invoice \$707.50 (9001-0042.41) - arrived via DHL courier, was sent to 90 Middlefield #180

March 25, 2002

COPY

FED EX

RLR 0800-0021 signed declaration

US MAIL - courier pickup

DSP 8325-0011 Notice re Acceptance of Fee Deficiency
DSP 3930-0911 Recorded Assignments (two)
DSP 8325-0027P2 Copy of Provisional Appln filed 3/21/02

RLR 9325-0001.40 Invitation to Correct Defects
RLR 0800-0024 Updated Filing Receipt
RLR 2300-0115.43 Yamamoto ltr re OA
RLR 9001-0016.66 CPA annuity receipt
RLR 9001-0033.44 CPA annuity receipt
RLR 0800-0009.41 CPA annuity receipt
RLR 0800-0009.51 CPA annuity receipt
RLR 5100-0005.40 IPER

NSB 5100-0002.42 Barovsky insts to pay annuity

GRF 9400-0002 ref from E. Johnson
GRF 2750-0241.40 copy of published PCT from B. McBrayer

US MAIL - mailman pm delivery

SL various CPA reminder notices

GRF 9400-? PXE-012.US Office Action

RLR 2300-0401.45 Kemp ltr re discussion w/Exr
RLR 2302-1238.40 Yamamoto ltr re assignment filed
RLR 9001-0048.44 Gowling ltr re confirmatory assignment
RLR 5050-0015 Office Action
RLR 3941-0001.20 Issue Notification
RLR 0800-? SN09/449,581 Issue Notification

DSP 6750-0002 Updated filing receipt

COPY

March 26 Mail Log

SL BNA Int'l. info re: subscription to world intellectual property report
DSP RO/US 8325-0011.41 PCT/RO/102, /105, /106
SL Baldwin Shelston Waters Invoice \$2,428.75
DSP Mewburn Ellis 8325-0007.43 designation fees/deadline 14 April 2002
DSP PTO 2225-0017P OFR

US Mail (pm delivery)

DSP 8325-0029P executed assignment from S. Brennan
DSP 8325-0010.40 copy of Written Opinion from S. Brennan
DSP 2300-0999.43 Kemp ltr w/filing receipt
DSP 3930-1000.01 PTO corrected filing receipt
DSP 6750-? Phillips Ormonde ltr re deadline for requesting exam
DSP 2300-15900 copy of Written Opinion from Chiron

RLR 5050-0040P PTO filing receipt
RLR 8900-0002.01 Notice of Abandonment

GRF 2750-0231 copy of corrected OFR from B. McBrayer

COPY

March 27, 2002

VIA DHL

RLR 9003-0001.40 executed POA and Power to Inspect

VIA FEDEX

DSP 8600-0010.40 executed appt of agent
DSP 8600-0007.40 executed appt of agent

VIA UPS

RLR 9002-0016.01 Novartis ltr re response to Final OA

US MAIL (pm delivery)

DSP 8325-2009.40 S. Brennan ltr re national phase instructions
DSP 8325-0007.42 Gowlings ltr re natl phase entry
DSP 6750-0007.41 Stanford insts to request examination

March 28, 2002

COPY

VIA FEDEX

DSP	8325-0021.40	formal drawings
RLR	5050-0032.40	appt of agent
RLR	5050-0031	signed declarations

VIA UPS

DSP	6210-0004	Jensvold returning assignment?
DSP	2300-1360	Advisory Action from R. Hale

US MAIL to 90 Middlefield Rd. (Delivered by B. Barnes)

DSP	2300-0037.04	copy of filing receipt
GRF	9400-0013.40	Notice of Receipt of Demand
GRF	9400-0013.40	Written Opinion
GRF	2302-1631.21	Notice to Comply

EXPRESS MAIL

DSP	8325-0007.44	Yamamoto ltr re appln filed
-----	--------------	-----------------------------

March 29, 2002

COPY

US MAIL

RLR	9000-0057.42	Philippine assoc confirmation copy
RLR	9000-0055.42	Philippine assoc confirmation copy
RLR	7777	B. Barnes ltr re 2001 operating expenses
DSP	2300-1651	Hale ltr re draft claims ok

MAIL LOG
April, 2002

COPY

<u>ATTY</u>	<u>DOC #</u>	<u>DESCRIPTION</u>
RLR	9001-0033.44	CPA-Official Receipt
RLR	9001-0016.66	CPA-Official Receipt
RLR	0800-0009.61	CPA-Official Receipt
RLR	0800-0009.41	CPA-Official Receipt
DSP	3930-8000	signed receipt of Assignment
RLR	222-0020	signed receipt of Assignment
RLR	5050-0012	PTO-Notice of Allowance
GRF	2750-0233	ltr w/copy of Notice of Allowance
DSP	8325-0010.40	PCT-Written Opinion
RLR	9003-0001	PTO-Filing Receipt
RLR	2300-0953.52	copy of ltr fr Chang w/english version of Amendment (two copies)
RLR	2300-1679	memo fr Guth w/copy of Office Communication
RLR	2300-1679.40	memo w/copy of PCT Written Opinion
DSP	5050-0031.40	PCT-Communication in Cases for Which no Other Form is Applicable
RLR	9000-0040.56	CPA-Official Receipt
RLR	9001-0001.40	ltr fr Gowlings re reponse due, signed POA; new formal drawings; copy of Appl.
RLR	9000-0049.45	ltr fr Gowlings re POA
RLR	5050-0025	PTO-Updated Filing Receipt
RLR	0800-0017.44	CPA-Official Receipt
DSP	3930-0909.42	ltr fr Gowlings w/copy of Notice of National Entry
RLR	3950-0001.40	PCT-Notification of the Recording a Change
DSP	8325-0012.40	PCT-Notification of the Recording a Change
DSP	8600-0002.40	PCT-Notification of the Recording a Change
DSP	6750-0002.40	PCT-Notification of the Recording a Change
DSP	8325-0018.40	PCT-Notification of the Recording a Change
DSP	8325-0019.41	PCT-Notification of the Recording a Change
DSP	8325-0019.40	PCT-Notification of the Recording a Change
RLR	5050-0026.40	PCT-Notification of the Recording a Change
DSP	8325-0023.40	PCT-Notification of the Recording a Change
RLR	9001-0042	PTO-Issue Notification
RLR	2300-0048.EPO	ltr fr Kemp re abandonment
RLR	9001-0015.02	Maintenance Fee reminder
NSB	2302-0402	ltr w/copy of Office Action
RLR	5050-009.40	PCT-Notification Concerning Payment of Prescribed Fees
RLR	2302-0366	ltr w/copy of Final Office Action
DSP	8325-0011	PTO-Office Communication
NSB	2300-1413	ltr fr Fida re amendments
RLR	9003-0001P	PTO-Notice of recordation & Assignment

MAIL LOG
April 2, 2002

COPY

ATTY	DOC #	DESCRIPTION
DSP	8325-0009.40	PCT-Notification of Xtl of Intl. Search Report or the Decl.
RLR	5050-0017.40	PCT-Notification of Xtl of Intl. Search Report or the Decl.
RLR	0800-0008.02	ltr w/copy of interview with the Examiner
RLR	0800-0016	ltr w/copy of interview with the Examiner
RLR	0800-0017	ltr w/copy of interview with the Examiner
RLR	5050-0032.40	PCT-Notice Informing the Appl. of the Comm. of the Intl. Appl. to Desg. Offices
DSP	2400-0004.40	PCT-Notification of Recording of a Change
DSP	3930-0911	signed receipt of Assignment
DSP	3930-0909.41	ltr fr Rice w/Direction to Request Examination
DSP	8325-0014.20	PTO-Filing Receipt & Notice to file Missing Parts
DSP	8325-0007	ltr fr Rice w/copy of Entitlement
DSP	860-0004.40	PCT-Notification of Recording of a Change
RLR	5998-0019.42	ltr w/copy of recent publ. Kupfner et al., <i>J. of Immun.</i> <u>167</u> :7044-7051 (2001)
RLR	9000-0049.44	ltr fr Gowlings w/official Notice of Ntl. Entry
GRF	9400-0007.55	conf. copy of ltr fr Yamamoto re claims

COPY

Atty Dkt: 5100-0707
USSN: 09/766,273
PATENT

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on November 15, 2002

11/15/02
Date

Dieme Kizer
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael Bittner *et al.*

Serial No.: 09/766,273

Art Unit: 1634

Filing Date: January 18, 2001

Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN SITU HYBRIDIZATION

SUPPLEMENTAL AMENDMENT UNDER 37 CFR §1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper supplements the response filed December 21, 2001, which response was considered by the patent office to be a bona fide attempt to comply with the sequence rules. An Office Action mailed March 20, 2002, with a shortened period of one month for response. Accordingly, a Response was initially due by April 20, 2002. However, because the Office Action was not received by the applicants, the response is being filed with a petition to revive the application. The Commissioner is hereby authorized to charge to Deposit Account No. 18-1648 any other fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, with the exception of the payment of the Issue Fee. Reconsideration of the application in view of the following remarks is respectfully requested.

Accompanying Documents

1. Computer-readable copy of the Sequence Listing on diskette;
2. Hardcopy printout of Sequence Listing.

Remarks

In the Communication dated March 20, 2002, the Patent Office requested applicants comply with the requirements of the sequence rules. Accordingly, submitted herewith is a computer-readable copy and a paper of the Sequence Listing, and statement in support of filing and submission in accordance with 37 C.F.R. §§1.821(c) and (e).

Respectfully submitted,

Date: November 15/2002 By: Narinder Banait

Narinder S. Banait, Ph.D.
Registration No. 43,482
Attorney for Applicants

ROBINS & PASTERNAK, LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Fax: (650) 325-7823

COPY

Atty Dkt No. 5100-0707

USSN: 09/766,273

PATENT

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11/15/02

Date

Signature

Tim Kizer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael Bittner *et al.*

Serial No.: 09/766,273 Art Unit: 1634

Filing Date: January 18, 2001 Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN SITU HYBRIDIZATION

**STATEMENT TO SUPPORT FILING AND SUBMISSION IN ACCORDANCE
WITH 37 C.F.R. §§ 1.821-1.825**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The undersigned hereby states that the content of the attached papers and the computer-readable copy of the Sequence Listing, submitted in accordance with 37 C.F.R. §§ 1.821(c) and (e), respectively, are the same.

Respectfully submitted,

Date: November 15/2002

By: Narinder S. Banait

Narinder S. Banait, Ph.D.
Registration No. 43,482
Attorney for Applicants

ROBINS & PASTERNAK LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Fax: (650) 325-7823



COPY

SEQUENCE LISTING

<110> Quantum Dot Corporation
The Government of the United States of America, as represented
by the Secretary, Department of Health and Human Services
Bittner, Michael
Wong, Edith Y.
Bruchez Jr., Marcel P.

<120> OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR NANOCRYSTALS FOR
MICROARRAY AND FLUORESCENCE IN SITU HYBRIDIZATION

<130> 5100-0707

<140> 09/766,273

<141> 2001-01-18

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<170> PatentIn Ver. 2.0

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<220>
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 with generic tag

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 with generic tag

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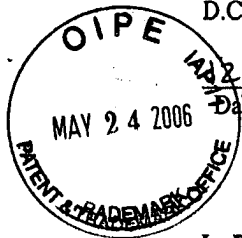


COPY

1621
Atty Dkt No. 5100-0707
USSN: 09/766,273
PATENT

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12/26/01 Susan LaMont
Date Signature

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

BITTNER et al.

Serial No.: 09/766,273

Art Unit: 1655

Filing Date: January 18, 2001

Examiner: Forman, Betty J.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE
IN SITU HYBRIDIZATION

AMENDMENT TRANSMITTAL LETTER

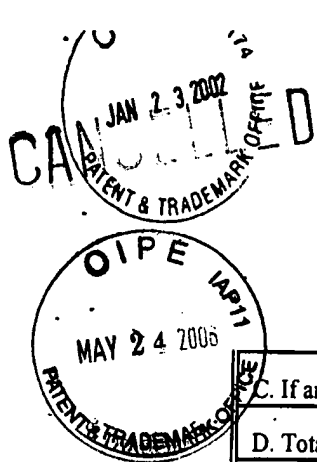
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is a Response to Restriction Requirement in the above patent application in response to the Office Action of November 27, 2001.

- ☐ Petition for Extension of Time enclosed.
- ☐ No additional fee is required.
- ☒ Also enclosed: Sequence Listing (paper and disk); Statement Regarding Sequence Listing; postcard

No. of Claims After Amendment			Most Claims Previously Paid		Extra Claims		Additional Fee		
A. Total Claims		-		=		x	\$18	=	\$
B. Ind. Claims		-		=		x	\$84	=	



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TECH CENTER 1600/2900

C. If amended to contain multiple dependent claims, add 280	\$280	=	\$
D. Total Amendment Fee (Total of A, B & C)		=	
E. If small entity, 50% reduction of Total Amendment Fee (50% of D)		=	
F. Total Amendment Fee (D minus E)		=	\$

- A check for \$ to cover the extension of time fee and extra claims fee is attached.
- Charge \$ to Deposit Account No. 18-1648.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: Dec 24/2001

By: Narinder S. Banait
Narinder S. Banait
Registration No. 43,482
Attorney for Applicants

ROBINS & PASTERNAK LLP
90 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: 650-325-7812
Facsimile: 650-325-7823

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PATENT & TRADEMARK OFFICE
MAY 2 4 2006

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Client No. 0008-US
PATENT

2-12-01
M

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MAY 2 4 2006
PATENT & TRADEMARK SERVICE

12/26/01 Date
Susan LaMont Signature

FEB 04 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

BITTNER et al.

Serial No.: 09/766,273

Group Art Unit: 1655

Filing Date: January 18, 2001

Examiner: Forman, Betty J

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN
SITU HYBRIDIZATION

RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Restriction Requirement dated November 27, 2001. The Examiner therein required election of one of the following groups of claims:

Group I, claims 1-38 and 44, drawn to a method of assaying a sample (classified in class 435, subclass 6); and

Group II, claims 39-43, drawn to a polynucleotide assay complex and kit (classified in class 536, subclass 24.3 and class 422, subclass 61).

Applicants hereby elect to prosecute the claims of Group I, claims 1-38 and 44, without traverse.

Applicants expressly reserve their right under 35 U.S.C. §121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application.

REQUIREMENT TO COMPLY WITH NUCLEIC ACID SEQUENCE RULES

The Examiner requested that the applicant provide a computer readable form, and a paper copy of the "Sequence Listing", as well as a statement that the paper and computer readable copies are the same. The applicants have complied with the sequence rules in their response to "Missing Parts" mailed on May 29, 2001. For the convenience of the office, the applicants herein provide a copy of the computer readable form and a written copy of the sequence listing and the Statement Regarding Sequence Listings as filed.

Please address all further communications to Roberta L. Robins at
Customer No. 20855.

Respectfully submitted,

Date: Dec 21/2001

By: Narinder Banait

Narinder S. Banait
Registration No. 43,482
Attorney for Applicants

ROBINS & PASTERNAK
90 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 325-7812
Fax: (650) 325-7823

Certificate of Mailing/Transmission (37 C.F.R. § 1.8(a)):

Pursuant to 37 C.F.R. § 1.8, I hereby certify that this paper and all enclosures are being deposited with the United States Postal Service as first class mail on the date indicated below in an envelope addressed to the Assistant Commissioner for Patents, Washington D.C. 20231.

Dated: 5/29/01Name of Person Certifying: David Maher

Printed Name: David W. Maher

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Michael BITTNER, et al.

Assignees: Quantum Dot Corporation and THE
GOVERNMENT OF THE UNITED STATES OF
AMERICA, as represented by the Secretary,
Department of Health and Human Services

Filing Date: January 18, 2001

Examiner: Not Yet Assigned

Serial No.: 09/766,273

Group Art Unit: 1645

Title: **OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR NANOCRYSTALS FOR
MICROARRAY AND FLUORESCENCE IN SITU HYBRIDIZATION**STATEMENT REGARDING SEQUENCE LISTING UNDER 37 C.F.R. §§ 1.821-1.825Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The Applicants hereby declare that the content of the computer-readable copy of the
Sequence Listing furnished herewith is the same as the written copy of the Sequence Listing.

Date: May 29, 2001

Respectfully submitted,

By: David Maher
David W. Maher
Registration No. 40,077McCutchen, Doyle, Brown & Enersen, LLP
Three Embarcadero Center
San Francisco, California 94111
Telephone: (650) 849-4908
Telefax: (650) 849-4800

COPY



SEQUENCE LISTING



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FEB 04 2002

TECH CENTER 1600/2900

<110> Quantum Dot Corporation

The Government of the United States of America, as represented by the
Secretary, Department of Health and Human Services

Bittner, Michael

Wong, Edith Y.

Bruchez, Marcel P. Jr.

<120> OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN SITU
HYBRIDIZATION

<130> 22564-0707

<140> US 09/766,273

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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,273	01/18/2001	Michael Pittner	22564-0707	1332

7590 11/27/2001
David W. Maher
McCutchen, Doyle, Brown & Enersen, LLP
Three Embarcadero Center
San Francisco, CA 94111



EXAMINER	
FORMAN, BETTY J	
ART UNIT	PAPER NUMBER
1655	11

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/766,273

Applicant(s)

BITTNER ET AL.

Examiner

BJ Forman

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <i>Notice to Comply</i> . |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-38 and 44, drawn to a method for assaying a sample, classified in class 435, subclass 6.
 - II. Claim 39-43, drawn to a polynucleotide assay complex and kit, classified in class 536, subclass 24.3 and classified in class 422, subclass 61.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product i.e. the polynucleotide complex and kit of Invention I can be used to identify polynucleotide-binding proteins.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1655

REQUIREMENT TO COMPLY WITH NUCLEIC ACID SEQUENCE RULES

5. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2).

However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Applicant is given ONE MONTH from the mailing date of this communication within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
November 20, 2001



W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**



Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: _____

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

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